

REMARKS

Applicants appreciate the thorough examination of the current application as evidenced by the Office Action dated August 25, 2006 (the "Action"). In response, Claims 9 and 10 have been amended to address the claim objections on page 2 of the Action. The rejections under Sections 112 and 103 are addressed below.

Applicants also appreciate the courtesy accorded by Examiner Julie E. Stein to the undersigned during a telephone interview on November 8, 2006 and again on November 16, 2006. The present remarks shall constitute an Interview Summary pursuant to MPEP §713.04.

During the interview, the above amendments to Claim 20 in response to the rejection under § 112 and the patentability of the pending claims was discussed. Examiner Stein indicated that the above amendments to Claim 20 would address the rejection under § 112. Agreement was not reached as to the patentability of the pending claims. However, Examiner Stein indicated that she would consider Applicants arguments. In the remarks that follow, Applicants will repeat the analysis that was made during the telephone interview, will respond to remarks made by the Examiner during the telephone interview, and will provide additional analysis as to why the pending claims are patentable.

I. Claims 20-22 Satisfy the Requirements of § 112

Applicants submit that Claim 20 as originally filed is clear and definite and satisfies the requirements of § 112. However, Claim 20 has been amended to expedite prosecution. Applicants submit that the amendments to Claim 20 do not impact the scope of the claims.

Accordingly, Applicants request that the rejections based on § 112 be withdrawn.

II. Independent Claims 1, 17 and 20 are patentable over Gray

Claim 1 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 20040203873 to Gray (Gray) in view of U.S. Patent

Application Publication No. 2005/0136949 to Barnes (Barnes). Applicants request reconsideration of the rejections under 103(a).

In particular, Applicants wish to reiterate the arguments of the Reasons in Support of Applicants' Pre-Appeal Brief Request for Review dated May 3, 2006 (the Pre-Appeal Brief Request), which arguments are hereby incorporated by reference in the present document. In addition, Applicants will now respond to the Response to Arguments in Sections 9-13 on pages 10-11 of the Action.

Claim 1 recites as follows:

1. A method for directing a mobile user to a wireless network access point comprising:
 - receiving a mobile user request for a location of a wireless network access point via a user terminal, wherein the user request comprises non-communication amenities;
 - identifying a geographic location of the mobile user responsive to receiving the user request; and
 - identifying a wireless network access point convenient to the user that provides access to the non-communication amenities.

Independent Claims 17 and 20 include recitations similar to Claim 1.

A. Section 9 of the Action

The Action characterizes the Pre-Appeal Brief Request as "attaching references individually where the rejections are based on combinations of references." Applicants wish to clarify that Section 103 requires that each and every element be disclosed in one of the references. *See* MPEP § 2142. Applicants submit that neither Gray nor Barnes teaches or suggests "identifying a wireless network access point convenient to the user that provides access to the non-communication amenities" as required by Section 103.

In particular, the Action concedes that Gray does not teach that the access point convenient to the user provides access to the non-communication amenities. Barnes discusses a "location module" that can determine a relative location of a device to a point of interest. However, neither Gray nor Barnes disclose "identifying a wireless network access point convenient to the user that provides access to the non-communication amenities" as recited in Claim 1. Therefore, Gray and Barnes cannot render Claim 1 obvious under Section

103 because Barnes and Gray do not disclose every recitation of Claim 1 as required by Section 103.

B. Section 10 of the Action

The Action states that "the features upon which applicant relies (*i.e.*, established communication link) are not recited in the claims." *See* page 10 of the Action. Applicants wish to clarify that that an established communication link is a feature of Barnes that teaches away from the claimed invention in the context of Barnes.

In particular, Section 103 requires that there be some motivation to combine the references. *See* MPEP §2142. It is improper to combine references where the references teach away from their combination. *See* MPEP § 2146 (X. D.). Barnes conveys information about points of interest to the user via an established communication link. *See* Barnes, paragraph 94-96. There is no motivation in Barnes to identify a wireless network access point because Barnes assumes that the user has an established communication link. Therefore, Barnes teaches away from "identifying a wireless network access point convenient to the user that provides access to the non-communication amenities" as recited in Claim 1, and the combination of Barnes and Gray is improper under Section 103.

C. Sections 11-13 of the Action

Sections 11-13 of the Action further respond to Applicants' argument that Barnes teaches away from selecting a communication network. The Action states that the claims recite "comprising" language, which does not limit the manner in which the service provider is selected. The Action further states that request is a broad term and states that in Barnes, paragraph 67, "request" is used to indicate that the mobile terminal is identifying and selecting a service provider.

Applicants agree that the term "comprising" does not limit the manner in which the service provider is selected in the current claims. Applicants also agree that the term "request" is broad. However, Applicants wish to clarify that it is simply not proper to combine references if the references teach away from the combination. *See* MPEP § 2146 (X.

D.). As discussed with respect to Section 9 of the Action above, Applicants submit that Gray and Barnes do not disclose every recitation of Claim 1. However, even if the combination of references taught every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. See MPEP § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998)).

The Action concedes that Gray does not teach that the user request includes non-communication amenities and that the access point convenient to the user provides access to the non-communication amenities. The Action relies on Barnes as allegedly disclosing user identified target points of interest, including non-communication amenities. See page 4 of the Action. The Action states that both references are from the same field of endeavor and the wireless network access point taught in Gray is another type of point of interest that may be located by the mobile terminal taught in Barnes. *Id.* Applicants respectfully disagree.

The standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention, *e.g.*, to recognize a wireless network access point as a "point of interest" in Barnes. The combination of Barnes and Gray under Section 103 is not proper because Barnes teaches away from directing a user to a particular WLAN network as proposed by Gray. The device of Barnes automatically selects a communication network from more than one available network. See Barnes, paragraphs 60, 64 and 65. The device of Barnes also includes programming for switching communication networks, such as when a network fails or slows down. See Barnes, paragraph 68. There is no motivation for the device of Barnes to direct a user to a particular WLAN network as proposed by Gray because the device of Barnes automatically selects an available network. See paragraph 65.

For at least these reasons, there is no motivation to combine Barnes and Gray under Section 103.

D. Summary

For at least the reasons discussed above and the reasons of the Pre-Appeal Brief Request, Applicants submit that independent Claims 1, 17 and 20 are patentable over Barnes and Gray. Neither Barnes nor Gray disclose "identifying a wireless network access point

convenient to the user that provides access to the non-communication amenities" as recited in Claim 1, and as such, cannot render Claim 1 obvious under Section 103. Moreover, there is no motivation to combine Barnes and Gray because Barnes teaches away from the disclosures of Gray for at least the reasons discussed above.

Independent Claims 17 and 20 include recitations analogous to Claim 1 and are patentable for at least the above reasons. Claims 2-7, 9-16, 18-19 and 21-22 are patentable at least per the patentability of the claims from which they depend.

III. Claim 10 is separately patentable over Gray

Claim 10 depends from Claim 1 and is patentable for at least the reasons discussed above. In addition, Claim 10 is separately patentable for at least the reasons that follow.

Claim 10 as amended recites as follows:

the user request includes a particular service provider associated with the wireless network, wherein identifying a wireless network access point further comprises identifying a wireless network access point provided by the particular service provider.

With respect to original Claim 10, the Action states on page 3 that an "ISP" is inherent. Claim 10 has been amended to clarify that, in some embodiments, the user request can include a particular service provider, and that a wireless network access point provided by the particular service provider can be identified. Accordingly, users can choose a particular service provider of an identified wireless network access convenient to the user. Applicants submit that this feature is not taught or suggested by the cited art, and that Claim 10 is therefore separately patentable over Gray for at least these reasons.

Conclusion

In view of the above, it is respectfully submitted that this application is in condition for allowance, which action is respectfully requested.

Attorney Docket No. 9400-44
Application Serial No. 10/646,962
Filed: August 25, 2003
Page 11

Respectfully submitted,

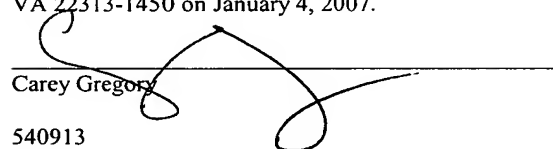


Laura M. Kelley
Registration No.: 48,441

USPTO Customer No. 39072
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

Certificate of Mailing under 37 CFR § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 4, 2007.



Carey Gregory

540913